

REMARKS/ARGUMENTS

The Office required restriction of Claims 1-12 to the following groups.

Group I: Claims 1-8 and 10, drawn to a process for producing fluorinated esters.

Group II: Claim 9, drawn to a process for producing fluorinated acyl fluorides.

Group III: Claims 11 and 12, drawn to a process for producing fluorinated vinyl ethers.

Applicants elect with traverse Group I (Claims 1-8 and 10), for further prosecution in the above-identified application. In addition, Applicants elect, with traverse, the following species: the compound (1b) (see pages 36-39 of the present specification), for examination purposes only. Claims 1-12 read on the elected species.

The Examiner has required restriction of the above groups, and a further election of species, based on the reasons noted on pages 2-5 of the present Office Action. Applicants respectfully traverse for the following reasons.

The Office has not made a proper restriction. Restriction is only proper if the claims of the restricted groups are either independent or distinct. There also must be a serious burden on the Examiner if restriction is required. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion in support of restriction (see MPEP § 803). Applicants respectfully submit that the Office has not demonstrated that it would be a serious burden to examine the entire application.

In regard to the restriction between Groups I and II, the Examiner characterized the inventions of these groups as related as mutually exclusive species in an intermediate-final product relationship, and provided only a general assertion that the intermediate product is deemed to be useful as precursors of perfluorinated ketones, as evidenced by WO 95/25082 (abstract). The Examiner further asserted that the inventions are deemed patentably distinct, since there is nothing on record to show them to be obvious variants. However, the Examiner

did not provide any reasons or examples, in terms of a description of such a use, for example, to support this assertion and to support a conclusion of restriction. Moreover, the burden is on the Office to provide reasons to conclude that the inventions are patentably distinct, and not on the Applicants to establish they are not. In addition, the claim of Group II depends from Claim 1, and as such, includes the process of Group I. Accordingly, the restriction should be withdrawn.

In regard to the restriction between Groups I and III, the Examiner characterized the inventions of these groups as related as mutually exclusive species in an intermediate-final product relationship, and provided only a general assertion that the intermediate product is deemed to be useful as precursors of perfluorinated ketones, as evidenced by WO 95/25082 (abstract). The Examiner further asserted that the inventions are deemed patentably distinct, since there is nothing on record to show them to be obvious variants. However, the Examiner did not provide any reasons or examples, in terms of a description of such a use, for example, to support this assertion and to support a conclusion of restriction. Moreover, as discussed above, the burden is on the Office to provide reasons to conclude that the inventions are patentably distinct, and not on the Applicants to establish they are not. In fact, the claims of Group III depend from Claim 10, and as such, Group III includes the process of Group I. Accordingly, the restriction should be withdrawn.

In regard to the restriction between Groups II and III, the Examiner provided only a general assertion that no patentable co-action exists between the inventions of these groups. However, the Examiner did not provide any reasons or examples to support this assertion and to support a conclusion of restriction. Accordingly, the restriction should be withdrawn.

Therefore, the Office has not supported its conclusion of restriction of the respective groups, and has not shown that it would be a serious burden to search and examine these

groups together. Applicants submit that a search of all the claims would not impose a serious burden on the office.

Applicants also submit that the Office has not provided any reasons or examples to support the conclusion of patentable distinctness with respect to the elected species, but rather, has merely stated that an election is required. Applicants note that for restriction to be proper, there must be a patentable difference between the species as claimed (see MPEP § 808.01(a)).

Applicants make no statement regarding the patentable distinctness of the species, but note that, for the election in this case, the Examiner generally required an election of species, as noted on page 4 of the present Office Action. However, the Examiner did not provide any reasons or examples to support the requirement for this election. Again, the burden is on the Office to provide reasons or examples to conclude that the inventions are patentably distinct, and not on the Applicants to establish that they are not.

Therefore, the Office has not supported its conclusion of the above election of species, and has not shown that it would be a serious burden to search and examine the pending claims together, and without a further restriction within each claim. Applicants' election of species is for examination purposes only.

Applicants also respectfully submit that if the invention is so narrowed, as to cover only the elected species, as noted above, Applicants cannot adequately claim the invention, without filing numerous patent applications. This is an undue burden on the Applicants.

Finally, with respect to the elected species, Applicants respectfully submit that should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, for at least the reasons presented above, the Office has failed to meet the burden necessary to sustain the requirement for restriction and election in the present

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application. Applicants respectfully request the withdrawal of the Restriction and Election of Species Requirement.

Applicants respectfully submit that the present application is in condition for examination on the merits, and request early notice of such action.

Respectfully submitted,

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